

REMARKS

Claims 1 through 9 are pending in this Application. Claims 1 and 3 through 6 have been amended, and claims 10 and 11 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as , for example, Figs. 2 through 7 and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Drawings

The Examiner asserted that Figs. 16A-D should be designated by an appropriate legend, such as "Prior Art". In response it is proposed to amend Figs. 16A-D by providing the legend "Prior Art" as suggested by the Examiner. A replacement sheet for Figs. 16A-D is submitted herewith as Exhibit A.

Claims 1, 3, 10 and 11 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Ichikawa et al.

In the statement of the rejection, the Examiner referred to Figs. 1(a)-(e) and related text, asserting the disclosure of a method and semiconductor device corresponding to those claimed. In so doing, the Examiner asserted that the manipulative step of removing a member covering a surface layer region of the section to become the outer lead of the lead frame is disclosed in column 4, lines 34 through 64. This rejection is traversed as factually inaccurate.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). Moreover, in imposing a rejection under 35 U.S.C. §102, the Examiner is required to specifically identify wherein an applied reference is said to disclose each and every feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed inventions and the method and device disclosed by Ichikawa et al. that scotch the factual determination that Ichikawa et al. disclose a method and device identically corresponding to those claimed.

Specifically, it is not apparent and the Examiner has not specifically identified, as judicially required, wherein Ichikawa et al. disclose or suggest the concept of removing a member covering a surface layer region of the section for use as the outer lead, as specified in claims 1, 10 and 11, much less the manipulative step of forming a groove ranging from the surface of the sealing resin to edges of the removable members as specified in claim 3. *In re Rijckaert, supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra*. Applicants have reviewed column 4, lines 34 through 64. However, it is not apparent wherein any of the foregoing argued manipulative steps are disclosed.

At any rate, in order to expedite prosecution, claims 1, 3, 10 and 11 have been clarified by reciting that the removing step occurs after the lead frame is removed from the

metal mold at which point it would contain the resin, and that not only is the member covering the surface layer region removed, but the sealing resin over the member is also removed. These manipulative steps are neither disclosed nor suggested by Ichikawa et al.

The above argued fundamental differences between the claimed methods and device and the method and device as disclosed by Ichikawa et al. undermine the factual determination that Ichikawa et al. disclose a method and device identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 3, 10 and 11 under 35 U.S.C. §102 for lack of novelty as evidenced by Ichikawa et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 2 and 4 through 9 were rejected under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Utsumi et al. and the acknowledged prior art.

In the statement of the rejection, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the methodology of Ichikawa et al. by employing a common mold, in view of Utsumi et al., and by employing detachable spacers referring to the acknowledged prior art, Fig. 16, element 6. This rejection is traversed as factually and legally erroneous.

Initially, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 3 under 35 U.S.C. §102 for lack of novelty

as evidenced by Ichikawa et al. Neither Utsumi et al. nor the acknowledged prior art cure the argued deficiencies of Ichikawa et al. Argot, even if the applied references are combined, and that is a big if with which Applicants do not agree, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Moreover, Applicants separately argue the patentability of claims 4 through 8. In this respect, the Examiner's reliance upon element 6 of Fig. 16C is as a detachable section is completely misplaced. As clearly disclosed at page 2 of the written description of the specification, lines 19 and 20, element 6 represents sections which in fact are the outer leads located outside of cavity 5. Element 6 is not a detachable spacer but the outer lead itself.

It should, therefore, be apparent that the Examiner did not establish a *prima facie* basis to deny patentability to claims 2 and 4 through 9 under 35 U.S.C. §103. Applicants, therefore, submit that the imposed rejection of claims 2 and 4 through 9 under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Utsumi et al. and the acknowledged prior art is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'AJS' followed by a stylized flourish.

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